IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Inventors:	William R. VAN ETTEN et al.	Group Art Unit:	3625
Serial No.:	09/604,472	Examiner:	Naeem U. Haq
For:	INFORMATION COMMUNICATION TRANSLATION PROTOCOL		

AFFIDAVIT UNDER 37 C.F.R. 1.132

I, TED FRIEL, am over 21 years of age, and if called to testify would be competent to testify as to the following matters:

(1) I have been a computer consultant for 35 years, attended college at the Dartmouth and Amos Tuck and received a Batchelor of Business Administration in year 1965 attended graduate school at the State University of New York at Buffalo and received a PhD in year 1969.

(2) My experience relevant to this case includes designing, analyzing or managing the development or implementation of procurement applications incorporating databases to be accessible over networks including the Internet.

(3) I have acted as an expert witness twice before in a patent prosecution matter.

(4) I have been employed for 5 years as a Systems Designer at ePlus, the Assignee of U.S. Patent Application No. 09/604,472 entitled "INFORMATION COMMUNICATION TRANSLATION PROTOCOL".

(5) I am being compensated for my time in preparing this Opinion by the Assignee; however I have no financial interest in the outcome of the prosecution of U.S. Patent Application No. 09/604,472.

(6) I am familiar with the prosecution history of Application No. 09/604,472: I have received copies of and read:

a. the patent application filed on June 27, 2000 as a continuation-in-part of patent application 09/348,698, filed on July 7, 1999;
b. the first Office Action mailed on February 28, 2003 and the references cited therein;
c. the Applicants' response to the first Office Action filed on May 28, 2003;
d. the second Office Action mailed on March 30, 2004 and the references cited therein;
e. the Office Interview conducted on August 3, 2004;
f. the Applicants' response to the second Office Action filed on August 30, 2004;
g. the third Office Action mailed on December 27, 2004 and the references cited therein; and
h. the Applicants' response to the third Office Action filed concurrent herewith.

(7) I am fully familiar with and deal with the following technologies on a regular basis:

a. The design, analysis and development of catalog databases of products wherein the catalog is arranged in a product classification hierarchy;
b. The design, analysis and development of procurement related systems;
c. Object oriented technology for both web and database applications.

TYPING ERROR IN CLAIM 20

Pending claim 20 is an original claim and as originally filed reads

"A procurement system as recited in claim 19, wherein said special requisition is forwarded to a supplier who provides the desired item, one of said databases being updated with said desired item according to said class, attribute and value relationships."

A typographical error inserting an 'l' in front of 'one' was apparently made in the amendment filed on May 28, 2003 and has been copied into the amendment filed on August 30, 2004. However, both amendments indicate that claim 20 is an original claim and therefore I am assuming the claim 20 reads as originally filed and included above.

THERE IS NO IMPEDANCE MISMATCH INHERENT IN ERICKSON

The IBM reference defines an impedance mismatch as one where the data model used in the application is different from that of the data model used in the database (page 4, 2nd paragraph). Erickson does not teach any type of object for classification, product, supplier and buyer data nor does Erickson teach any type of database or any type of query language. Hence, *there is no impedance mismatch inherent in Erickson* that would motivate the modification thereof with the OODBMS of IBM, as alleged by the Examiner to address such an impedance mismatch.

ERICKSON COMBINED WITH IBM IS INSUFFIENT TO ACHIEVE THE PRESENT CLAIMED INVENTION

At least at col. 16, line 1 et seq., Erickson teaches a system for

A. a company to submit to a service provider company, classification, and/or product information, where a company is a buyer and/or a supplier, and the company uses a database update message;
B. a service provider to
    a. extract the appropriate information from the update message and store it into a central database or global database; and
    b. optionally transfer the extracted information from the central database to a local database;
C. a buyer to:
    a. browse the database and identify a list of suppliers that should receive a bid request,
    b. create a message and response tracking object using the list of identified suppliers;

c. send the data cast message to the list of identified suppliers requesting a bid be sent from each of the identified suppliers to the buyer;
d. until a deadline expires, track bid responses and send reminders to identified suppliers who have not responded;
e. receive bid responses from the identified suppliers and store the response in the message and response tracking object;
f. evaluate the bid responses; and
g. when the deadline has expired, analyze supplier bid responses.

At least at col. 9, line 38 et seq., Erickson teaches a database that optionally contains classifications to help locate companies or products, where a classification may comprise:

a. a classification ID;
b. classification description; and
c. other classification identification information.

Erickson teaches that company profiles (either buyer or supplier) and products may link to these various classifications in order to identify the classes of goods and services offered by a particular company and available in the database.

Erickson teaches, in effect, an index to buyers, suppliers, and goods/services by classification. There is no teaching or suggestion of relating classes of goods/services to one another, as claimed by the present invention (claims 17-25) and, therefore, Erickson does not teach information on which to base such relationships. That is, in the teaching of Erickson there are no class relationships, no attribute relationships, and no value relationships.

At best, Erickson teaches an index that groups suppliers, buyers and products/services by class.

Therefore, even assuming for the sake of argument that one would be motivated to modify Erickson to use the OODBMS of IBM, there is no class relationship data taught by Erickson. *Erickson does not contain sufficient teachings to define and implement a product class hierarchy.* So, a modification of Erickson by IBM would have to be further modified by some other reference that teaches how to relate classes of the classification taught by Erickson. Finally, there is no problem identified by Erickson or even inherent in the teachings of Erickson

that would motivate such a further modification to the classification taught by Erickson except that a modification of Erickson by IBM requires such a further modification to Erickson.

ERICKSON TEACHES A DIFFERENT INVENTION

Erickson teaches a system comprising a central database and at least one remote database that collectively contain supplier profiles and goods/services descriptions and may contain classifications that profiles and descriptions are linked to. Because new data can be entered at any time into any of the remote databases in Erickson's system, Erickson teaches data synchronization by sending updates to the central database from the remote sites, the central site entering the changes into the central database, and sending a replicate of all or part of the central database back to the remote sites. Thus, Erickson inherently teaches that the central database is possibly out of synch with a remote database because a remote database can be updated at any time without correspondingly updating the central database. However, Erickson teaches that when updates are sent from a remote database to the central database, all of the affected remote databases can be simultaneously synchronized therewith on a periodic basis. Thus, at any given moment the databases can be out of synchronization.

Erickson teaches that to locate suppliers a user may search the remote database associated with that user *as well as* the central database. Erickson *nowhere teaches not locating a desired item* when searching any database and then, as a result, searching another database for the desired item. That is, Erickson *nowhere teaches an item selection procedure to search for the desired item within a second database when it is* not located *within a first database*, as recited by claim 17 and Erickson does teach searching the central database as well as the remote database a user has access to. Given that Erickson teaches searching both the central and the remote database, that Erickson nowhere teaches not finding a desired item, and Erickson does not teach even finding a desired item, it is not inherent in Erickson that a user searches a second database when a desired item is not found in a first database, as alleged by the Examiner. Erickson's teachings are directed to finding a possible supplier of an item and requesting a bid from that supplier for a desired item and is not directed toward finding desired items but only finding possible suppliers of a desired item.

The present invention recites claims for ***sourcing*** "on demand" items that are NOT in a catalog that is normally available to a user (Claim 19), and for items that are NOT in ANY catalog that is normally available to the user (Claim 20). The Examiner inferred that items would not be in a local catalog because Erickson teaches that a local database can get out of synchronization with a central database and that when this occurs a search is made of the central database to find the item, or vice versa. Nowhere does Erickson teach or suggest sourcing items that are not in either the central or remote database as recited by the present claimed invention.

The present invention claims updating one of said databases with the sourcing information of the desired item that was not found in any catalog normally accessible to the buyer (claim 20). The present claimed invention recites a product classification that is based on product class relationships, product attribute relationships and product value relationships to organize catalog items (claim 17) and is hierarchical (claim 22). When a buyer searches for an item in a catalog, the buyer does so using the product classification (claim 17). When a buyer cannot find a desired item in any assessable catalog, the buyer can use the attributes and values of related items in the classification system to partially define the desired item in a special requisition (claim 19). When the desired item is sourced (when a supplier is located for the item not in the catalog), the desired item can be fully described using the class relationships, attribute relationships and value relationships of the product classification, and can then be placed in the catalog in a "right place" (claim 20). Nowhere does Erickson teach updating a database to include goods/services information for an item not found in any database normally accessible to the buyer (claim 20).

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful statements may jeopardize the validity of the application or any patent issuing thereon.

Ted Friel
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4-27-05
DATE

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Witness: Jon Spatola

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